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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,235	08/26/2003	Ryoji Watanabe	116939	1746

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EXAMINER	
PAHNG, JASON Y	
ART UNIT	PAPER NUMBER
3725	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/647,235	WATANABE ET AL.	
	Examiner	Art Unit	
	Jason Y. Pahng	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-11 and 13-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-11 and 13-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 9 and 10 are objected to because of the following informalities:

With regard to claim 9, the phrase, "the data destroy unit" (line 3) should be corrected to "the destroy process unit" in order to be consistent with a preceding claim.

With regard to claim 10, the phrase, "the image display unit" (line 3) should be corrected to "the image display member" in order to be consistent with a preceding claim.

Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The image display member of claim 1 already includes an electronic data storage device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by DaRosa (US D443,230).

With regard to claims 1 and 5, DaRosa discloses a destroy process unit comprising a scissors and a container) that destroys data stored in an electronic data storage device of an image display member or a credit card, and a shredding process unit comprising a scissors that shreds the image display member or a credit card. A credit card inherently displays an image of a credit card number.

With regard to claim 2, DaRosa inherently discloses making the credit card number image be invisible by shredding the credit cards.

With regard to claim 15, DaRosa's apparatus is capable of destroying an image display member comprising paper.

Claims 1, 2, 5, 11, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (US 6,676,050). Chang discloses a destroy process unit (1) that destroys data stored in an electronic data storage device of an image display member or a CD, and a shredding process unit (20, 30) that shreds the image display member or a CD. A CD inherently displays an image, including a label image.

With regard to claim 11, Chang discloses a sensor (14) which senses the presence of an image display member in order to control at least the shredding process.

With regard to claim 15, Chang's apparatus is capable of destroying an image display member comprising paper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 6,676,050) in view of Abramson (US 4,931,770) and Matsumoto et al. (US 4,879,724). Claim 4 calls for at least one of electric or magnetic application, and claim 9 calls for electromagnetic wave to overwrite another data to destroy data. In a closely related art, Matsumoto discloses a rewritable optical disk memory system (column 1, lines 21-23) and therefore inherently discloses overwriting another data to in order to destroy data. In another closely related art, Abramson teaches that using abrasive, cutting, chemical, magnetic, or other suitable component adapted to destroy information on a disc is well known in the art (column 2, lines 30-32). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Chang with a rewritable optical disk memory system in order to destroy data in a disc, as such is well known in the art and taught by Matsumoto and Abramson.

Claim 8 does not add any further limitation to claim 4. The use of electric field claimed in claim 4 would inherently include application of voltage.

Claims 1, 2, 5, 6, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatanaka (US 4,192,467) in view of Brady et al. (US 6,100,804).

With regard to claims 1, 2, and 15, Hatanaka discloses an image display member or paper shredder including a destroy process unit (52) capable of destroying data stored in a thin electronic data storage device of an image display member (A) or paper, and a shredding process unit (94) for shredding the image display member. Hatanaka

does not specifically recite destroying a paper with a thin electronic data storage device. However, in a closely related art pertinent to the problem, Brady discloses a paper with a thin electronic data storage device (Figure 22) in order to store electronic data in a paper. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Hatanaka with a paper with a thin electronic data storage device in order to store electronic data in a paper, as taught by Brady.

With regard to claim 5, Hatanaka discloses a destroy process unit (52) destroying the data storage device or a paper physically.

With regard to claim 6, Hatanaka discloses an insertion port (46) from which the image display member (A) is inserted. The destroy process unit (52) is disposed closer to the insertion port (46) than the shredding process unit (94).

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatanaka (US 4,192,467) in view of Brady et al. (US 6,100,804) as applied above, further in view of Abramson (US 4,931,770). Claim 4 calls for the destroy process unit to use an electric or magnetic field instead of physical means in order to destroy data. In a closely related art, Abramson teaches that any one of abrasive, cutting, chemical, or magnetic process may be used in order to destroy data (column 2, lines 26-37). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Hatanaka (as modified) with any one of the means taught by Abramson, including a magnetic destroy unit.

With regard to claim 7, Hatanaka discloses the shredding process unit (94) followed by a data destroy unit (52).

Claim 10, as well as can be understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 6,676,050) in view of Bennett et al. (US 6,758,392). Chang discloses a sensor to detect an image display unit, but does not disclose detecting an electronic data storage device. In a closely related art, Bennett discloses a credit card destroy process unit with a sensor and controller capable of detecting an electronic data storage device in order to control the destruction (column 1, lines 28-39 and 62-66). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Chang with a sensor and controller capable of detecting an electronic data storage device in order to control the destruction, as taught by Bennett.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over DaRosa (US D443,230) in view of Bley (US 6,038,012). Claims 13 and 14 call for the electronic data storage device to comprise an IC chip. In a closely related art pertinent to the problem, Bley discloses an electronic data storage device comprising an IC chip (column 1, lines 56-58) in order to make a card to be a smart card. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide DaRosa with an electronic data storage device comprising an IC chip in order to make his card to be a smart card, as taught by Bley.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, and 4-11 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

The invention disclosed in the application, including all of the major details in the disclosure, appears to contain allowable subject matter. However, each of the claimed invention is rejected as above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Y. Pahng whose telephone number is 571 272 4522. The examiner can normally be reached on 9:00 AM - 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571 272 4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JYP

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